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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,208	10/31/2003	Simon C. Chu	RPS920030114US2	9985

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IBM Corporation
Intellectual Property Law Dept.
9CCA/B002
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EXAMINER

STOYNOV, STEFAN

ART UNIT PAPER NUMBER

2116

DATE MAILED: 03/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/698,208	Applicant(s) CHU ET AL.	
	Examiner Stefan Stoynov	Art Unit 2116	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- * Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 2 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 7-10, 14-17, and 21 of copending Application No. 10/674,838. Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitations in claims 1 and 2 are disclosed in claims 1-3, 7-10, 14-17, and 21 of copending Application No. 10/674,838.

Claims 1 and 2 are nearly identical to claims 1-3, 7-10, 14-17, and 21 of copending Application No. 10/674,838 except that claims 1 and 2 in the current application recite “a service for managing a secure network boot of a server blade”, whereas claims 1-3, 7-10, 14-17, and 21 of copending Application No. 10/674,838 recite “a method, a system, and a computer program product for managing a secure network boot of a server blade”. The

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referred claims encompass any one of "a service, a method, a system, and a computer program product for managing a secure network boot of a server blade".

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frye, JR., US Paten Appl. Pub. Num. 2003/0126426, in view of Schell et al., US Patent Num. 6,314,520, and further in view of Pan et al., US Patent Appl. Pub. Num. 2004/0081104.

Re claim 1, Frye discloses a service for managing a secure network boot, the service comprising:

broadcasting a request for a boot program from a server to a network of management servers (paragraph 0008, lines 8-15, paragraph 0018, lines 11-24, FIG. 2, 112, 114, two separate 120 – i.e. plurality of management serves in a network);

receiving a response to the request for the boot program, the response being from a responding management server on the network of management servers, the response containing directions to a boot program server (paragraph 0019, lines 1-7, lines 25-30, paragraph 0044, lines 3-9, FIG. 2, 115, 120, 130);

transmitting the response from the responding management server to the server, and downloading a boot program from a boot program server specified by the responding management server (paragraph 0019, lines 25-30, paragraph 0020, lines 1-22, paragraph 0022, lines 10-16, paragraph 0023, lines 4-8);

generating an alert to a designated administrator server of a presence of an unauthorized management server on the network of management servers (paragraph, 0047, lines 1-22).

Frye fails to disclose storing a list of trusted management servers, comparing an identity of the responding management server with a list of trusted management servers, upon verifying that the responding management server is on the list of trusted management servers,

transmitting the response from the responding management server (this step was addressed by Frye as indicated above and was added here for clarity)

upon determining that the responding management server is not on the list of trusted management servers, blocking the transmittal of the response from the responding

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management server to the server, and upon determining that the responding management server is not on the list of trusted management servers,

generating an alert to a designated administrator server of a presence of an unauthorized management server on the network of management servers (this step was addressed by Frye as indicated above and was added here for clarity).

Schell teaches a networked client/server computer system configured to establish a trusted workstation (column 1, lines 20-22). Schell further teaches each workstation having a network interface card (NIC), which establishes a trusted connection between the workstation and the server (column 3, lines 62-65, FIG. 1, 14, 20) through which the workstation communicates with the server over the computer network (column 4, lines 5-7, FIG. 1, 12, 14). In addition, Schell further teaches the NIC card containing a trusted computing base (TCB) extensions that provide for securely booting the workstation, the "TBC extensions" referring to extensions of the server's TCB that operate as part of the workstation's network trusted computing base (column 2, lines 3-11) (i.e. database of trusted servers contained on the NIC). Schell also teaches an address confirmation circuit, wherein upon receipt of a packet, the source address of the received packet is compared for verification that it was sent from an authorized server (i.e. identity verification) (column 2, lines 30-35, column 3, lines 6-11, column 4, line 64- column 5, line 2, column 5, lines 13-22). In Schell, the pre-boot modules are downloaded to the workstation from known trusted servers only (column 2, lines 50-54, column 3, lines 45-49) after meeting the identity verification criteria. Download from untrusted servers is blocked (column 5, lines 20-22). Thus, the security of the information stored on a client/server is ensured (column 1, lines 56-59).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to use the system and method of storing a trusted computing base (TCB) extension corresponding to trusted boot servers within a NIC used for communication over a network, the process or identity comparison and verification of the received network packets, and based upon that comparison downloading pre-boot modules to the client machine from trusted servers or blocking the download of pre-boot modules, as suggested by Schell with the service disclosed by Frye in order to implement storing a list of trusted management servers, comparing an identity of the responding management server with a list of trusted management servers, upon verifying that the responding management server is on the list of trusted management servers, transmitting the response from the responding management server, upon determining that the responding management server is not on the list of trusted management servers, blocking the transmittal of the response from the responding management server to the server, and upon determining that the responding management server is not on the list of trusted management servers, generating an alert to a designated administrator server of a presence of an unauthorized management server on the network of management servers. One of ordinary skill in the art would be motivated to do so in order to ensure security of the information being downloaded to the server blade.

Frye and Schell fail to disclose the service for managing a secure network boot (addressed above) of a server blade, the server blade being in a blade chassis that has multiple server blades, the blade chassis including a switching means allowing the server blade to communicate with a network.

Pan teaches a blade server having a rack with several chassis where the sever blades within each chassis communicate with each other and with the network through network switches (paragraph 0015, lines 3-10, FIG. 1, 10, 12, 14, 16, 20). In Pan, the network switches incorporate a PXE configuration agent used for secure automatic download of a configuration image during power or boot up of the blade server (paragraph 0017, lines 1-21, paragraph 0018, lines 1-9, paragraph 0010, lines 1-4). Thus, configuration time is saved and erroneous downloads are prevented (paragraph 0010, lines 4-12).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to use the blade server architecture incorporating network switches allowing the server blades to communicate with the network and the method of secure download of configuration images, as suggested by Pan with the with the service disclosed by Frye and Schell in order to implement managing a secure network boot of a server blade, the server blade being in a blade chassis that has multiple server blades, the blade chassis including a switching means allowing the server blade to communicate with a network. One of ordinary skill in the art would be motivated to do so in order to save configuration time and prevent erroneous downloads to the server blade.

Re claim 2, Frye and Schell further disclose the service, further comprising:

coordinating different types of boot program servers available to the server blade by maintaining, in an information technology services organization logically oriented between the different types of boot program servers and the server blade (Frye, paragraph 0022, lines 1-20), a permission list of boot program servers authorized for each server blade in a server blade chassis (Schell, column 2, lines 3-11).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefan Stoykov whose telephone number is (571) 272-4236. The examiner can normally be reached on 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne Browne can be reached on (571) 272-3670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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